

Application No.: 10/774,520
Amendment dated: August 7, 2006
Reply to Office Action of March 7, 2006
Attorney Docket No.: 21295.73 (H5749US)

b.) Remarks

Claims 1-17 are pending in this application. Claims 1-8, 12-13 and 14-17 have been amended in various particulars as indicated hereinabove to correct the literal translation of the Claims from the counterpart German priority application and present the Claims in the form customary in the US patent practice.

Turning first to the Office Action Summary Sheet, Claims 1-17 are pending in this application. Claims 1-17 are rejected.

Turning now to the merits, Claim 1 was rejected under 35 U.S.C. 112, second paragraph. Claim 1 has been rewritten. Applicant believes that Claim 1 is now in compliance with 35 U.S.C. 112, second paragraph.

Claims 1, 2-8, 9-12, 13-15, 16 and 17 were rejected under 35 U.S.C. 103(a) over Kian et al. (U.S. 2003/0092267). This rejection is respectfully traversed for the following reasons.

First, Applicant asserts that this citation would have been proper only if considered by a person of average skill in the art at the time the invention was made. It has been well established that a person skilled in the art is not a layperson, nor one skilled in remote arts¹.... Applicant asserts that Kian is remote, non-analogous art that should not have been cited to make the rejection.

To determine whether a publication is analogous, two criteria are used: 1) whether the art is from the same field of endeavor, and 2) if the publication is not from the same field of endeavor, whether it is still reasonably pertinent to the particular problems with which the inventor is involved. If a cited publication is directed to a different purpose, the inventor, accordingly, has had less motivation or occasion to consider it.²

¹ *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693 (Fed. Cir. 1983).

² *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, (Fed. Cir. 1992), see also *Heidelberger DruckmaschinenAG v. Hantscho Comm. Prods., Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1994).

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In view of this standard, Kian is a non-analogous publication. Kian's disclosure describes ablating at least one conductive layer of a multilayered conductor/plastic substrate structure. An excimer laser is employed to rapidly and precisely ablate a pattern from a mask into at least one conductive layer. According to a preferred method, the excimer laser is employed and controlled to ablate portions of the at least one conductive layer without completely decomposing the at least one functional layer therebeneath. (Abstract of Kian). Paragraph 112 of Kian, referenced by the Patent Office, describes employing feedback for adjusting the laser control parameters (e.g., laser energy at the surface, pulse width, etc.) to compensate for surface uniformity variations. Paragraph 113 of Kian, referenced by the Patent Office, describes an alternative ablation system in which controlling laser ablation of the multilayered ablated structure is achieved by by precisely controlling the scan velocity and overlapping adjacent scans by 50%.

It is evident that controlling the process of laser ablating of a conducting layer of a conductor/plastic substrate structure in Kian has nothing to do with the problem of achieving faster scanning speed during the relative motion between a camera and a semiconductor wafer in the field of image acquisition and non-invasive optical inspection of the whole surface of a semiconductor wafer. Therefore, the teaching of Kian is from a completely different field of endeavor.

Moreover, the problem of laser ablating a conductive layer of a conductor/plastic substrate structure and optimizing the quality of ablation in Kian cannot be considered reasonably pertinent to the problem of faster non-invasive optical analysis of the whole surface of a semiconductor wafer described in the present application. The ablation of a conductive material in Kian deals with providing laser energy to the conductive surface of the multi-layered structure sufficient to burn a pattern in the material of the ablated surface. Since the ablated surface has its own properties and imperfections, Kian describes improvements of the laser ablation process to achieve the desired ablation results. Nothing could be found in the disclosure of Kian that would be of any pertinence to the non-invasive optical analysis and the problem of fast non-invasive scanning of a wafer solved by Applicant. Therefore, the disclosure of Kian is directed to a completely

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different purpose and a person of average skill in the Applicant's art would have no reason or motivation to consider Kian at the time the invention was made.

Therefore, Applicant asserts that Kian is remote, non-analogous art that should not have been cited to make the rejection.

Second, The Patent Office has not created a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cite publication or in the knowledge generally available to one of ordinary skill in the art, to modify the publication or to combine its teachings. Second, there must be a reasonable expectation of success. Finally, the publication (or publication when combined) must teach or suggest each and every element of the claim³. With regard to some suggestion or motivation to modify the publication or to combine publication teachings, as well as to a reasonable expectation of success, it has been well articulated that a factual inquiry whether to combine publications must be based on objective evidence of record⁴ and that teachings of publications can be combined only if there is some suggestion or incentive to do so⁵.

Applicant respectfully points out that Kian fails as a publication upon which the Patent Office could have based its obviousness rejection. There is no way Applicant could have been motivated to modify the teachings of Kian to come up with the invention at the time the invention was made and claimed in the pending Claims. The priority filing date of the present application is February 21, 2003, as reflected in the filing receipt mailed 08/09/2004 and from the certified German priority document filed together with the present application. The teachings of Kian became first available on its publication date, which is May 15, 2003. It would have been impossible for Applicant to consider the teachings of Kian and modify them to come up with the present invention at the time the invention was made at least about 3 months prior to the day when the teachings of Kian became available. Therefore, there is no way the Patent Office has established the *prima facie* case of obviousness of the pending Claims over Kian.

³ MPEP 2142-2143

⁴ In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

⁵ In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

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Therefore, it is respectfully requested that this rejection be withdrawn and the pending Claims be allowed.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

Houston Eliseeva LLP

By Maria Eliseeva
Maria Eliseeva
Registration No.: 43,328
Tel.: 781 863 9991
Fax: 781 863 9931

4 Militia Drive, Suite 4
Lexington, Massachusetts 02421
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